

REMARKS

1. Claims 1-22 are pending in the Application. The Examiner has rejected Claims 1-5, 7-16, and 8-22. The Examiner has found allowable subject matter in Claims 6 and 17, provided they are rewritten to include all the limitations of the base claim and intervening claims from which they depend. Reconsideration of the application is requested.

2. The principal reason for not allowing a patent on the claimed subject matter is a rejection of claims under 35 U.S.C. § 102(b) over the Richter reference, U.S. Pat. No. 5,913,555. The crux of the matter appears to be whether the reference discloses all the limitations of the inventions claimed in the claims of the application, and, very importantly, whether the patentee or Applicant is allowed to be his or her own lexicographer.

3. The specification defines a "multi-axis" measuring machine as one "having linear axes or rotary axes of motion." Specification, p. 3, lines 6-7. The specification also states that the "measuring device may be a multi-axis coordinate measuring machine 40, having a base 42 and at least one linear axis 44, and preferably having at least one rotary axis 46." Specification, p. 5, lines 10-12. In addition, common meanings of "multi" include "more than one." Merriam-Webster's Collegiate Dictionary, 10th ed. at 764. Thus, an axis was defined as an axis of motion, and the term "multi-axis" means more than one axis. Therefore, a "multi-axis digital measuring device" is a measuring device having more than one axis of motion. Applicants request reconsideration of the application in light of this definition.

4. The primary reference, U.S. Pat. No. 5,913,555 to Hermann Richter et al. ("Richter"), discloses a digital camera taking a two-dimensional image, but does not describe or suggest a multi-axis measuring device. A camera cannot be "multi-axis," since at most a camera would include an ability to focus, i.e., to move the lens in or out, thus yielding a single "axis" of motion. A camera with a single axis of motion cannot be a "multi-axis digital measuring device." Applicants submit that whether the Amendment filed on August 18, 2003, is entered or not, Claims 1 and 12 claim "a multi-axis digital measuring device" that is not anticipated by the Richter reference, since a camera with a single axis does not anticipate a "multi-axis digital measuring device."

5. The undersigned discussed the case briefly with Examiner Cozart on October 6, 2003, and with the Examiner's supervisor, SPE Gregory A. Vidovich. The discussion focused on the scope of claims, and how claim terms are to be interpreted. SPE Vidovich pointed out that the PTO is obliged to give claim terms their broadest reasonable scope. The undersigned stated that a patentee is allowed to be his own lexicographer, and to define claim terms within the patent specification. Claim terms relevant to Claim 1 were discussed. Agreement was not reached. The undersigned volunteered to produce case law demonstrating that claim terms may be interpreted in light of use of the claim terms within the specification. SPE Vidovich agreed to consider such arguments.

6. Recent case law, citing to established case law, notes that claims are interpreted in light of the specification, and broad or narrow interpretation turns on how the specification characterizes the claimed invention. *Alloc, Inc., v. ITC*, No. 01-1222, 01-1291, slip opinion at 11 (Fed. Cir. Sept. 10, 2003) (interpreting claim terms narrowly where the specification made clear that the claim terms included "play" whether explicitly claimed or not). Where a specification makes clear that the claimed invention is narrower than the claim language might imply, the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, whether the guidance is provided in an explicit definitional format or not. *SciMed Life Systems, Inc., v. Advanced Cardiovascular Systems, Inc.*, 58 U.S.P.Q.2d 1059, 1065 (Fed. Cir. 2001).

The patent Examiner is required to give claims their broadest reasonable interpretation in view of the specification and the file history, keeping in mind that the inventor may be his own lexicographer and provided only that the intended meaning of the claim term is clear. *In re Dance*, 48 U.S.P.Q.2d 1635, 1638-39 (Fed. Cir. 1998 (looking to the specification and drawings for claim interpretation); see also *In re Bass*, 65 U.S.P.Q.2d 1156, 1158 (Fed. Cir. 2002) (using the specification to define claim terms). In interpreting claims, the patentee may have acted as his own lexicographer and imbued the claim terms with a particular meaning or "disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction." *Texas Digital Sys. v. Telegenix, Inc.*, 64, U.S.P.Q.2d 1812, 1819 (Fed. Cir. 2002).

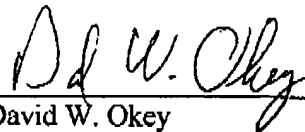
So long as the meaning of an expression is made reasonably clear and its use is consistent within a patent disclosure, an inventor is permitted to define the terms of his claims; the place to

do so is in the specification of the inventor's application. *Lear Siegler, Inc. v. Aeroquip Corp.*, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (emphasis added).

Accordingly, the claim term "multi-axis digital measuring device" should be interpreted according to the definition given to the term in the specification of the application. The specification defines a "multi-axis" measuring machine as one "having linear axes or rotary axes of motion." Specification, p. 3, lines 6-7.

7. Applicants submit that the Claims are in form for allowance, and respectfully request the Examiner to allow Claims 1-22. If the Examiner does not believe that the claims are in form for allowance and that a new search is required, the Examiner is requested to withdraw the finality of the present Office Action.

Respectfully submitted,

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